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Humberto C. Portillo

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EXAMINER

MILEF, ELDA G

ART UNIT

PAPER NUMBER

3694

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/604,525	<b>Applicant(s)</b> PORTILLO ET AL.	
	<b>Examiner</b> Elda Milef	<b>Art Unit</b> 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 16,18-42,44-66,70-92,94-116,118-138 and 140-159 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16,18-42,44-66,70-92,94-116,118-138 and 140-159 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of the Claims***

1. This office action is in response to the amendments submitted by the applicants on 1/19/2010.

- Claims 1-15, 17, 43, 67-69, 93, 117, 139 are cancelled.
- Claims 16, 42, 68, 92, 116, and 138 are amended.
- Claims 16, 18-42, 44-66, 70-92, 94-116, 118-138, and 140-159 are pending in the application.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/19/2010 has been entered.

### ***Specification***

3. The abstract of the disclosure is objected to because the Abstract exceeds 150 words. Correction is required. The abstract should be in narrative form and generally limited to a single paragraph within the range of 50 to 150 words. The abstract should not exceed 15 lines of text. Abstracts exceeding 15 lines of text should be

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checked to see that it does not exceed 150 words in length since the space provided for the abstract on the computer tape by the printer is limited. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 16, 18, 23-26, 32-35, 37-39, 42,44, 49-52, 58-61, 63-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over German et al.( US 2007/0136189) in view of Allen (US 2001/0025271).

**Re claim 16:** German disclose:

providing a money transfer system for electronic communications with at least the seller computer, wherein the money transfer system is operative for electronic communications with one or more buyer accessible payment location local computers operated at one or more payment locations and physically accessible to the buyer to

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make a payment (a computer implemented service that enables payment for a transaction to be transferred from the buyer to a seller) [0010-0011]; (an intermediary facilitates the transfer of money from the buyer to the seller) [0045]; (payor (buyer) computer Fig. 2 (220) and

receiving at the money transfer system an electronic payment request from the seller computer in response to a proposed transaction between the buyer and the seller, the payment request comprising information including at least a transaction amount (seller creates electronic invoice for the transaction including the bid price, shipping and handling charges and total price Figs. 9-11, and [0181]) ;

German disclose the auction site assigning a transaction ID wherein the unique transaction number is associated with the transaction between the buyer and seller Fig. 9 (960) and [0178]. German do not disclose assigning, by the money transfer system a unique transaction number to the payment request, wherein the unique transaction number is associated with the transaction between the buyer and the seller. Allen however, teaches a confidential transaction provider facilitating the purchasing process and transferring funds to the seller from the buyer and assigning a unique confidential transaction number to a transaction between the buyer and seller [0030, 0032-0035]). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify German to include a unique transaction number assigned by the confidential transaction provider as taught by Allen in order to reference the transaction when transferring payment from the buyer to the seller.

German further disclose:

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determining by the money transfer system a preliminary total amount required from the buyer in connection with the transaction comprising at least the transaction amount; determining by the money transfer system a grand total amount based upon the preliminary total amount and any other applicable charges; communicating information from the money transfer system to the seller computer system for displaying at least the grand total amount and the unique transaction number to the buyer computer system (the invoice is created by the seller through a Web page provided by the payment enabler. The invoice includes bid price, shipping charges, handling charges and the total price [0181] and Fig. 9 steps (970-995); Fig. 11);

receiving at the money transfer system a payment notification associated with the unique transaction number from the payment location local computer, wherein the payment notification indicates payment in the amount of the grand total amount has been submitted in person\_at the payment location by or on behalf of the buyer (Flash cash processor notifies the payment enabler that the buyer has completed the prearranged deposit Fig. 4A step 480A) and (Flash Cash is a payment instrument that enables a payor to execute payment orders over the Internet based on a prearranged cash deposit, A payor first communicates over the Internet with a flash cash processor in order to prearrange the cash deposit, the payor then physically visits a location registered with the flash cash processor. At the registered location, the payor deposits cash. At a later time, the payor can instruct the flash cash processor over the Internet to pay the deposited amount or less to a payee.[0052], [0106-0110]) ;

communicating a message to the seller computer system that payment

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associated with the unique transaction number has been received at a payment location upon receipt of the payment notification by the money transfer system (German disclose the routine 640 begins with step 710, in which the payment enabler 240 notifies the seller 130 that payment is guaranteed upon acceptance of goods by the buyer 110.-see [0159] and Figs. 4A, 3, 6, and 7 (in particular step 710) ; and

effecting completion of the electronic payment request by making payment via the money transfer system to the seller upon receipt of the payment notification by the money transfer system (payment transferred by payment enabler from buyer to seller 0154-0155]).

**Re claim 18:** German disclose wherein the payment location local computer is a stand-alone computing system with money transfer capabilities (the payor physically visits a location registered with the flash cash processor to deposit cash [0052].

**Re claim 23:** German disclose wherein the seller computer displays a plurality of selectable payment methods for selection by the buyer in connection with the transaction, the payment methods including a cash payment method, and wherein the payment request is generated by the seller computer system in response to selection by the buyer of the cash payment method. German disclose the personal merchant account and the online cash register are integrated with the transaction facilitator 230, the transaction facilitator being an online site at which the seller has a virtual storefront. German further disclose the transaction facilitator may automatically send the buyer to the seller's online cash register in order to pay. The seller creates the online cash register and determines acceptable payment methods to offer to the buyer through the

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online cash register.[0195]. The buyer is provided with instruments to complete the transaction such as Flash cash, credit card, EFT, virtual private payment account of payor, physical check. Fig. 1B.

**Re claims 24 and 26:** German disclose:

wherein the payment request information includes buyer identification information (unique user ID)[0070-0073];

further comprising the step of generating a unique data record corresponding to the payment request and storing the data record in a staging area associated with the money transfer system (unique id used to track information pertaining to user and as a key to a database record accessing user and transaction information.[0070]).

**Re claim 25:** German disclose wherein the preliminary total amount comprises the sum of the transaction amount, shipping charges, and any applicable transaction fees (seller defines additional charges to be added to the price [0198]).

**Re claim 32:** German disclose wherein the payment made by the buyer at the payment location is by cash, credit card, or check. (A payor first communicates over the Internet with a flash cash processor in order to prearrange the cash deposit, the payor then physically visits a location registered with the flash cash processor [0052], [0106-0110]).

**Re claim 33:** German disclose wherein the information provided in the step of communicating information to the seller computer system for displaying to the buyer computer system includes instructions to the buyer that payment in the grand total amount should be tendered to a payment location (flash cash [0052], [0106-0110]).

**Re claim 34:** German do not explicitly disclose displaying to the buyer computer information as to a plurality of payment locations at which actual payment may be. German however, do disclose the payor visits flash cash locations that must be registered with payment location therefore, it is obvious that buyer would be informed of available locations [0052]. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to display locations registered with the flash cash processor in order for the payor to make a successful payment.

**Re claim 35:** German disclose wherein a payment gateway is positioned to communicate information between the seller computer and the money transfer system Fig. 2( payment enabler, payment processor).

**Re claim 37:.** German disclose wherein the payment request includes an order number provided by the seller computer (transaction ID [0180]).

**Re claims 38, 39:** German disclose wherein the seller is a merchant and operates an Internet-accessible web site for conducting transactions with buyer computers; wherein the seller is a seller on an online auction system (figs. 1 and 2 and related text, [0002]).

**Claims 42, 44, 49-52, 58-61, 63-65** have similar limitations found in claims 16, 18, 23-26, 32-35, and 37-39 above, and therefore are rejected by the same art and rationale.

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5. Claims 19-22, 28, 30-31, 41, 45-48, 54, 56-57, 67, 68, 70-76, 78, 80-85, 87-89, 91, 92, 94-100, 102, 104-109, 111-113, 115, 116, 118-123, 125, 127-132, 134-136, 138, 140-145, 147, 149-154, 156-158 are rejected under 35 U.S.C. 103(a) as being unpatentable over German et al. in view of Allen as applied to claim 16 above, in further view of Gutierrez-Sheris (hereinafter Gutierrez, US Patent No. 6,938,013).

**Re claims 19, 20, 21, 22, 28:** German do not disclose:

wherein payment to the seller comprises the grand total amount expressed in the local currency of the seller, less any applicable transaction fees;

comprising the step of determining a buyer local exchange rate for the preliminary total amount based upon buyer information provided from the buyer computer system to the seller computer system, and thence to the money transfer system;

wherein the buyer information comprises buyer address information including a country;

determining a seller local exchange rate for the funds due to the seller based upon seller information provided by the seller computer; and

determining a grand total amount expressed in the local currency of the seller, based upon the grand total amount and the determined seller local exchange rate, less any applicable charges.

Gutierrez however, teaches a money-transfer system wherein the total amount due is expressed in the currency of the beneficiary [seller] and the currency of the customer [buyer], and customer [buyer] information includes address.-see Table 3 col. 8

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lines 34-65 and col. 7 lines 19-col. 8 line 5, Fig. 1.. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify German and Allen to include the total amount expressed in the currency of the beneficiary [seller], currency of the buyer [customer], determining an exchange rate, and customer [buyer] information includes the customer's address as taught by Gutierrez in order to allow the payee to access funds in the local currency and eliminate the extra step of currency exchange.

**Re claims 30, 31:** German and Allen do not disclose the step of, in further response to information from a payment location local computer that payment in the amount of the grand total amount has been received at the payment location, communicating a money transfer control number (MTCN) to the payment location for provision to the buyer; further comprising the step of providing a receipt to the buyer at the payment location, the receipt bearing at least the money transfer control number (MTCN).

Gutierrez however, teaches a transaction receipt including a control number in Table 3 col. 8. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify German and Allen to communicate a control number in regards to the money transfer request as taught by Gutierrez in order to track the money transfer transaction using a unique number.

**Re claim 41:** German disclose step of accessing information stored at the money transfer system including the grand total amount due from the buyer (database [0062]), German do not disclose in response to receipt of a message from a payment location

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including the unique confirmation number, and communicating the grand total amount to the payment location. Gutierrez however, teach a selling agent [payment location] performing money transfers per request of a customer, the transaction information and receipt is forwarded from the money transfer system to the payment location (selling agent)-see fig. 7 and related text. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify German and Allen to include the payment location and money transfer system communicating transaction information as taught by Gutierrez in order to enable accurate and timely money transfers.

**Claims 45-48, 54, 56-57, 67** have similar limitations found in claims 19-22, 28, 30-31, 41 above, and therefore are rejected by the same art and rationale.

**Claims 68, 92, 116, 138** have similar limitations found in claims 16 and 20 in combination, and therefore are rejected by the same art and rationale.

**Claims 70-76, 78, 80-85, 87-89, 91** have similar limitations found in claims 18-19, 21, 23-26, 28, 30-35, 37-39, 41 above, and therefore are rejected by the same art and rationale.

**Claims 94-100, 102, 104-109, 111-113, 115** have similar limitations found in claims 18-19, 21, 23-26, 28, 30-35, 37-39, 41 above, and therefore are rejected by the same art and rationale.

**Claims 118-123, 125, 127-132, 134-136** have similar limitations found in claims 18-19, 21, 23-26, 28, 30-35, 37-39 above, and therefore are rejected by the same art and rationale.

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**Claims 140-145, 147, 149-154, 156-158** have similar limitations found in claims 18-19, 21, 23-26, 28, 30-35, 37-39 above, and therefore are rejected by the same art and rationale.

6. Claims 27, 40, 53,66 are rejected under 35 U.S.C. 103(a) as being unpatentable over German et al. in view of Allen as applied to claims 16 and 42 above in further view of Godwin (Godwin, Nadine. "The Changeover to Computers Puts Shiplines in New Waters", Travel Weekly, v44, pg 19(2), Dec. 23, 1985)

**Re claims 27, 40:** German fails to disclose:

storing the data record in a payment confirmation queue in response to receipt of the information from the payment location that payment has been actually made at the payment location, as specified in claims 27, 53, 77, 101, 124; and

maintaining device queue records comprising lists of messages awaiting delivery, messages currently being delivered, and messages awaiting confirmation of delivery, as specified in claims 40, 66, 90, 114, 137, 159.

Godwin however, teaches using queues for payments and maintaining device queue records –see p. 3, pars. 3-8. ("The cruise lines keep tabs on other agent activity besides bookings, by checking the queues frequently...Besides the confirmation queue, there are the option payment and final payment queues and the cancellation queue...If the deposit has not arrived by two days before the due date, the agency's PNR appears in the cruise line's option payment queue and a message goes into the agency's queues as well. If the payment also does not show up on the due date, the PNR will be

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dropped into the expired option queue...The final payment queues work in the same way, giving notice to the shipline and the agency two days before money is due and dropping the PNR into the expired final payment queue...”)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify German and Allen to include payment queues as taught by Godwin in order to track electronic sales activity.

**Claims 53, 66**, have similar limitations found in claims 27, 40 above, and therefore are rejected by the same art and rationale

7. Claims 29, 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over German in view of Allen as applied to claims 16 and 42 above in further view of Kraus (Kraus, James R. “Regulators Target Illegal Money-Transfer Firms States Fear companies Abuse Immigrant clients, Laundering of Drug Funds” American Banker. New York, NY: Aug. 24, 1998. Vol. 153, Iss. 165; pg. 3).

**Re claim 29:** German and Allen do not disclose the step of determining whether an amount associated with the transaction exceeds a predetermined compliance limit, and requesting additional information from the buyer in response to a determination that said amount exceeds the predetermined compliance limit. Kraus however, disclose transaction reporting laws in transfers over a \$10,000 limit pg. 1 full text para. 5. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify German and Allen to include identifying when a transfer is over a legal limit as taught by Kraus in order to identify suspicious

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transactions.

**Claim 55** has similar limitations found in claim 29 and is therefore rejected using the same art and rationale.

8. Claims 36, 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over German in view of Allen as applied to claims 16 above in further view of Kudelski (US 5,497,418).

**Re claim 36:** German do not explicitly disclose canceling the transaction if the buyer does not make payment at a payment location within a predetermined time period however cancelling a transaction due to non-payment is old and well known in the art as evidenced by Kudelski (col. 16 lines 5-7). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify German and Allen to explicitly disclose cancelling a transaction due to non-payment as evidenced by Kudelski in order to protect the seller from a loss.

**Claims 62** has similar limitations found in claim 36 above, and therefore is rejected by the same art and rationale.

9. Claims 77, 90, 101, 114, 124, 137, 146, 159 are rejected under 35 U.S.C. 103(a) as being unpatentable over German et al. in view of Allen and Gutierrez as applied to claims 68, 92, 116 above in further view of Godwin.

**Claims 77, 90, 101, 114, 124, 137, 146, 159** have similar limitations found in claims 27, 40 above, and therefore are rejected by the same art and rationale

10. Claims 79, 103, 126, 148 are rejected under 35 U.S.C. 103(a) as being unpatentable over German in view of Allen and Gutierrez as applied to claims 68, 92, 116 above in further view of Kraus.

**Claims 79, 103, 126, 148** have similar limitations found in claim 29 above, and therefore are rejected by the same art and rationale.

11. Claims 86, 110, 133, 155 are rejected under 35 U.S.C. 103(a) as being unpatentable over German in view of Allen and Gutierrez as applied to claims 68, 92, 116 above in further view of Kudelski (US 5,497,418).

**Claims 86, 110, 133, 155** have similar limitations found in claims 36 above, and therefore are rejected by the same art and rationale.

### ***Response to Arguments***

12. In response to the amendment of the claims, the Examiner withdraws the 35 U.S.C. §112 first and second paragraph rejections.

Applicant's arguments with respect to the claims 16, 18-42, 44-66, 70-92, 94-116, 118-138, and 140-159 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Stoutenburg et al. (US 6,488,203) -cash payment for remote transactions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elda Milef whose telephone number is (571)272-8124. The examiner can normally be reached on Monday -Friday 9:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571)272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elda Milef/  
Examiner, Art Unit 3694

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